

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claim 1 is currently pending. Claim 1 has been amended by the present amendment. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter; the Office indicated that priority under 35 U.S.C. § 120 has not been granted due to the Office Action's position that the claims do not satisfy 35 U.S.C. § 112, first paragraph; the Office Action indicates that a new Declaration is required; Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,100,784 to Takemoto et al. (hereinafter "the '784 patent") in view of Japanese Application Publication No. JP 58049636 (hereinafter "the '636 patent"); Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,627,015 to Takemoto et al. (hereinafter "the '015 patent") in view of the '636 patent; and Claim 1 was rejected on the grounds of non-statutory obvious-type double patenting as being unpatentable over Claim 6 of the '015 patent in view of the '636 patent.

Amended claim 1 is directed to a method of adhering a first member to a second member via an intermediate member, the method comprising: (1) positioning the first member and the second member relative to each other; (2) applying a first adhesive to a first surface destined to comprise a first interface between the first member and the second member; (3) applying a second adhesive to a second surface destined to comprise a second interface between the second member and the intermediate member; (4) contacting the first member to the intermediate member via the first adhesive to form the first interface; (5) contacting the second member to the intermediate member via the second adhesive to form

the second interface; and (6) curing the first adhesive and the second adhesive using UV light, wherein, during the curing step, the intermediate member can move due to contraction of at least one of the first adhesive and the second adhesive due to curing, wherein the curing step includes filtering the light such that a color of the intermediate member is maintained. Further, Claim 1 recites that after curing, the first member and the second member are fixed to the intermediate member and therefore fixed to each other. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.¹

In particular, Applicants note that the specification states that “in the above condition, the positional relations between the part 2 and the intermediate member 4 and between the part support 3 and the intermediate 4 are quite likely to differ from the time of position adjustment to the time of completion of the assembly ... errors ascribable to the contraction of the adhesive due to curing can be corrected by the position adjustment beforehand because the positional deviation of the individual member is proportional to the amount and area of application of the adhesive.” Moreover, Applicants note that page 4, lines 9-13 of the specification state that “if light for curing the adhesive applied to the interface is not uniformly distributed, a part of the adhesive is rapidly cured while the other part is slowly cured. As a result, the thickness of the adhesive layer differs from the part cured rapidly to the part cured slowly.” Thus, the specification discloses that the thickness of the adhesive layer will not only change with the curing process, it will depend on whether the adhesive is cured rapidly or cured slowly. In light of the above, Applicants respectfully submit that the specification provides support for contraction of adhesives due to curing. Moreover, Applicants respectfully submit that, as shown for example in Figures 25-29, adhesive is applied between the intermediate member 4 and the first and second members 2 and 3. Thus, it follows that if the specification provides explicit support for contraction of the adhesive due

¹ See, page 51, lines 2-13 which correspond to paragraph [0157] in the published application. Emphasis added.

to curing, it also provides support for the intermediate member being able to move due to contraction of the at least one of the first adhesive and the second adhesive given that the intermediate member is not held in place by other forces as shown, e.g., in Figures 25-29. Accordingly, for the reasons stated above, Applicants respectfully submit the specification does not add new matter.

Applicants respectfully submit that the statements regarding the specification, Applicants claim to priority, and the need for a new declaration are rendered moot by the present amendment to Claim 1.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103 based on the '784 patent, the Office Action asserts that the '784 patent discloses everything in Claim 1 with the exception of curing using UV light and filtering the light such that the color of the intermediate member is maintained, and relies on the '636 patent to remedy that deficiency.

The '784 patent is directed to a construction method for mounting an ink jet head assembly to an ink-jet printer, wherein intermediate members are positioned between each head and a head holder, and the intermediate members are fixed to the head holder by an adhesive. However, as admitted in the outstanding Office Action, the '784 patent fails to disclose that the curing step includes filtering the light such that a color of the intermediate member is maintained, as recited in Claim 1.

The '636 patent is directed to a glass filter for hardening of coating material, adhesive agents, etc. by UV radiation. In particular, the '636 patent discloses that coloration of an adhesive agent, ink, coating material, etc. by UV radiation having wavelengths of 250-350 nm is prevented and that radiation having a wavelength of 360 nm is effective for hardening these materials. However, Applicants respectfully submit that the '636 patent fails to disclose that the curing step includes filtering the light such that a color of the intermediate member is maintained, as recited in amended Claim 1. Rather, the '636 patent merely

discloses that coloration of the adhesive agent, ink, or coating material is prevented when these materials are hardened by UV radiation when a filter is used. The '636 patent does not teach or suggest that an intermediate member that contacts both a first member and a second member via first and second adhesives, maintains its color, as required by Claim 1. The '636 patent only states that the coating material or adhesive does not change color when it is hardened by UV radiation.

Thus, no matter how the teachings of the '784 and '636 patents are combined, the combination does not teach or suggest filtering light such that a color of the intermediate member is maintained, as recited in Claim 1. Accordingly, Applicants respectfully traverse the rejection of Claim 1.

For reasons stated above, Applicants respectfully submit that no matter how the teachings of the '015 patent and the '636 patent is combined, the combination does not teach or suggest filtering light such that a color of the intermediate member is maintained, as recited in Claim 1. The '015 patent discloses limitations analogous to the limitations disclosed by the '784 patent, as previously discussed. Accordingly, Applicants respectfully submit that amended Claim 1 patentably defines over an proper combination of the '015 and '636 patents.

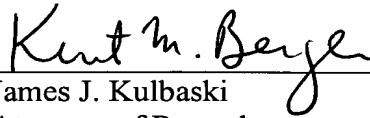
Applicants respectfully traverse the double patenting rejection of Claim 1 based on the '015 and '636 patents. As discussed above, the '636 patent fails to disclose filtering the lights such that a color of the intermediate member is maintained. Accordingly, no matter how the teachings of the '015 and '636 patents are combined, the combination does not teach the filtering step recited in Claim 1. Accordingly, Applicants respectfully traverse the double patenting rejection of the claims.

Thus, it is respectfully submitted that independent Claim 1 patentably defines over any proper combination of the '784, '015, and '636 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)

Kurt M. Berger, Ph.D.
Registration No. 51,461